

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of

**Paul Jarrett et al**

Application No. 09/856,221

Filed: August 20, 2001

For: **INSECTICIDAL AGENTS**

Examiner: **K. C. Srivastava, Ph.D.**

Group Art Unit: 1651

Attorney Docket No. 0380-P02546US0

Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**DECLARATION OF DEPOSITED MATERIALS**

As an authorized official (Commercial Manager) of, and on the instructions of, Horticulture Research International (HRI), the assignee of the above-identified application, and depositor of *Xenorhabdus bovienii* strains H3I and I73, which were deposited with the NCIMB, Aberdeen, Scotland on November 5, 1998, and which were assigned the Accession Nos. NCIMB 40985 and NCIMB 40986, respectively, I, Peter Little, declare and state as follows:

1. Horticulture Research International (HRI) is the assignee of the entire right title and interest in and to the invention which is the subject of the above-identified patent application, as well as to the application and any patent granted thereon. A copy of the assignment document transferring the inventors' rights in the aforementioned invention, patent application and patent to HRI is attached as Exhibit A.

2. HRI deposited the following biological materials identified and referred to in the specification of this application and on the deposited receipts, attached as Exhibit B1 and B2, and which were deposited under the terms of the Budapest Treaty (hereinafter "the deposits").

| <u>Accession No.</u> | <u>Depositor's Reference</u> | <u>Date Deposited</u> |
|----------------------|------------------------------|-----------------------|
| NCIMB 40985          | x. bovienii H31              | November 5, 1998      |
| NCIMB 40986          | x. bovienii I73              | November 5, 1998      |

3. As the deposits have been deposited and accepted under the terms of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, the filing of a viability statement is believed to be unnecessary [37 C.F.R. 1.807(b)]. Copies of the Viability Statement issued to HRI for the deposits pursuant to Rule 10.2 by the International Deposit Authority are nevertheless attached as Exhibits C2 and C3.
4. The deposits will be maintained for a term of at least 30 years from the date of deposit and at least 5 years after the date of the most recent request for the furnishing of a sample of the deposited material or for the enforceable life of any patent issuing from the above-identified application, whichever is longest.
5. The deposits will be replaced during the term of deposit should either of them become contaminated or no longer viable.

6. Subject to 37 C.F.R. § 1.808(b), all restrictions imposed by the depositor on the availability to the public of the deposits will be irrevocably removed upon the granting of a patent issuing from the above-identified patent application.
7. Access to the deposits is permitted during the pendency of the above-identified patent application to one determined by the Commissioner of Patent and Trademarks to be so entitled under 37 C.F.R. § 1.14 and 35 U.S.C. § 122.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 101 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

By (signature) \_\_\_\_\_

Peter Little  
Commercial Manager, Horticulture Research International

Date: 23 July 2003

EXHIBIT A

USA

**ASSIGNMENT OF UNITED STATES PATENT APPLICATION**

**Recitals:**

**WHEREAS**

(1) PAUL JARRETT, residing at 14 Home Furlong, Wellesbourne, Warwick, CV35 9TW, United Kingdom and

(2) JAMES MORGAN, residing at 46 Gorof Road, Ystradgynlais, Swansea, Powys, SA9 1DS, United Kingdom and

(3) DEBBIE ELLIS, residing at 7 Cooke Close, Warwick, CV34 5YG, United Kingdom (together/collectively hereinafter referred to as "the Inventors") have invented certain new and useful improvements in:

INSECTICIDAL AGENTS the specification of which was filed as United States Patent Application No. 09/856,221, filed in the USPTO 18 May 2001, (hereinafter referred to as "the Application")

**AND WHEREAS** HORTICULTURE RESEARCH INTERNATIONAL, a body corporate incorporated and registered in England and having a principal place of business at Wellesbourne, Warwick, CV35 9EF, United Kingdom (hereinafter referred to as "the Assignee") is desirous of acquiring the entire right, title and interest, for the United States of America, in and to the Application and the invention and improvements therein disclosed, and any Letters Patent which may issue therefor in the United States of America and all divisionals, continuations, reissues, re-examinations, renewals, and extensions thereof.

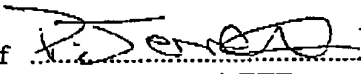
**Operative Provisions:**

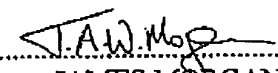
**NOW THEREFORE** in consideration of Ten Dollars (\$10.00) and other good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged the Inventors hereby **ASSIGN** absolutely unto the Assignee all their right, title and interest in and to the Application and the invention and improvements therein disclosed, for the United States of America, and any patents granted on the Application including any divisionals, continuations re-issues, re-examinations, renewals, and extensions thereof, and including the right to sue for and recover damages in respect of past infringement, the said interest being the entire ownership of the said Letters Patent when granted, to be held and enjoyed by the Assignee to the full end of the term for which the said Letters Patent may be granted, as fully and entirely as the same would have been held and enjoyed by the Inventors if this assignment had not been made.


And the Inventors authorize and request the Commissioner of Patents to issue the said Letters Patent to the Assignee.

And for the consideration aforesaid, the Inventors agree that the Inventors will, upon request, communicate to the Assignee or the representatives thereof any facts known to the Inventors respecting the invention or improvements of the Application, and will, upon request, but without expense to the Inventors, testify in any legal proceedings, sign all lawful papers, execute all divisional, continuation, reissue, re-examination, renewal and extension applications, and generally do all other and further lawful acts deemed necessary or expedient by the Assignee or by counsel for the Assignee to assist or enable the Assignee to obtain and enforce full benefits from the rights and interests herein assigned.

This assignment shall be binding upon the Inventors' heirs, executors, administrators, successors and assigns, and shall inure to the benefit of administrators, successors and assigns, as the case may be, of the Assignee.

(1) Signature of  Date: 1<sup>st</sup> March 2002  
PAUL JARRETT

(2) Signature of  Date: 1<sup>st</sup> March 2002  
JAMES MORGAN

(3) Signature of  Date: 1<sup>st</sup> March 2002  
DEBBIE ELLIS

BUDAPEST TREATY ON THE INTERNATIONAL  
RECOGNITION OF THE DEPOSIT OF MICROORGANISMS  
FOR THE PURPOSES OF PATENT PROCEDURE

Horticulture Research International  
Wellesbourne  
Warwickshire  
CV35 9EF

INTERNATIONAL FORM

RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT  
issued pursuant to Rule 7.1 by the  
INTERNATIONAL DEPOSITARY AUTHORITY  
identified at the bottom of this page

NAME AND ADDRESS  
OF DEPOSITOR

|  |  |
|--|--|
| I. IDENTIFICATION OF THE MICROORGANISM   |  |
| Identification reference given by the<br>DEPOSITOR:<br><br><i>Xenorhabdus bovienii</i><br>131  | Accession number given by the<br>INTERNATIONAL DEPOSITARY AUTHORITY:<br><br>NCIMB 40985  |
| II. SCIENTIFIC DESCRIPTION AND/OR PROPOSED TAXONOMIC DESIGNATION   |  |
| <p>The microorganism identified under I above was accompanied by:</p> <p><input type="checkbox"/> a scientific description</p> <p><input checked="" type="checkbox"/> a proposed taxonomic designation</p> <p>(Mark with a cross where applicable)</p>   |  |
| III. RECEIPT AND ACCEPTANCE  |  |
| <p>This International Depositary Authority accepts the microorganism identified under I above, which was received by it on<br/>5 November 1998<br/>(date of the original deposit)</p>  |  |
| IV. RECEIPT OF REQUEST FOR CONVERSION  |  |
| <p>The microorganism identified under I above was received by this International Depositary Authority on<br/>(date of the original deposit) and a request to convert the original deposit to a deposit under the Budapest Treaty was received by it on<br/>(date of receipt of request for conversion)</p> |  |
| V. INTERNATIONAL DEPOSITARY AUTHORITY  |  |
| <p>Name: NCIMB Ltd.,</p> <p>Address: 23 St Machar Drive,<br/>Aberdeen,<br/>AB24 3RY,<br/>Scotland.</p>   | <p>Signature(s) of person(s) having the power to represent the<br/>International Depositary Authority or of authorised<br/>official(s):</p> <p>Date: 9 November 1998</p> |

Where Rule 6/4(d) applies, such date is the date on which the status of International Depositary Authority was acquired.

Form BP/4 (see page)

## EXHIBIT B2

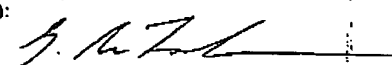
BUDAPEST TREATY ON THE INTERNATIONAL  
RECOGNITION OF THE DEPOSIT OF MICROORGANISMS  
FOR THE PURPOSES OF PATENT PROCEDURE

Horticulture Research International  
Wellesbourne  
Warwickshire  
CV35 9EF

## INTERNATIONAL FORM

RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT  
issued pursuant to Rule 7.1 by the  
INTERNATIONAL DEPOSITARY AUTHORITY  
identified at the bottom of this page

NAME AND ADDRESS  
OF DEPOSITOR

|  |   |
|--|---|
| I. IDENTIFICATION OF THE MICROORGANISM   |   |
| Identification reference given by the DEPOSITOR:<br><br><i>Xenorhabdus bovienii</i><br>173   | Accession number given by the INTERNATIONAL DEPOSITARY AUTHORITY:<br><br>NCIMB 40986  |
| II. SCIENTIFIC DESCRIPTION AND/OR PROPOSED TAXONOMIC DESIGNATION   |   |
| <p>The microorganism identified under I above was accompanied by:</p> <p><input type="checkbox"/> a scientific description</p> <p><input checked="" type="checkbox"/> a proposed taxonomic designation</p> <p>(Mark with a cross where applicable)</p>   |   |
| III. RECEIPT AND ACCEPTANCE  |   |
| <p>This International Depositary Authority accepts the microorganism identified under I above, which was received by it on 5 November 1998 (date of the original deposit)<sup>1</sup></p>  |   |
| IV. RECEIPT OF REQUEST FOR CONVERSION  |   |
| <p>The microorganism identified under I above was received by this International Depositary Authority on (date of the original deposit) and a request to convert the original deposit to a deposit under the Budapest Treaty was received by it on (date of receipt of request for conversion)</p> |   |
| V. INTERNATIONAL DEPOSITARY AUTHORITY  |   |
| <p>Name: NCIMB Ltd.,</p> <p>Address: 23 S. Machar Drive,<br/>Aberdeen,<br/>AB24 3RY,<br/>Scotland.</p>   | <p>Signature(s) of person(s) having the power to represent the International Depositary Authority or of authorised official(s):</p>  <p>Date: 9 November 1998</p> |

<sup>1</sup> Where Rule 6/4(d) applies, such date is the date on which the status of International Depositary Authority was acquired.

Form BP/4 (single page)

BUDAPEST TREATY ON THE INTERNATIONAL  
RECOGNITION OF THE DEPOSIT OF MICROORGANISMS  
FOR THE PURPOSES OF PATENT PROCEDURE

Horticulture Research International  
Wellesbourne  
Warwickshire  
CV35 9BF

INTERNATIONAL FORM

VIABILITY STATEMENT  
issued pursuant to Rule 10.2 by the  
INTERNATIONAL DEPOSITARY AUTHORITY  
identified on the following page

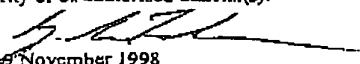
NAME AND ADDRESS OF THE PARTY  
TO WHOM THE VIABILITY STATEMENT  
IS ISSUED

|   |   |
|---|---|
| I. DEPOSITOR  | II. IDENTIFICATION OF THE MICROORGANISM   |
| Name: AS ABOVE<br>Address:  | Accession number given by the<br>INTERNATIONAL DEPOSITARY AUTHORITY:<br>NCIMB 40985<br><br>Date of the deposit or of the transfer <sup>1</sup> :<br>5 November 1998 |
| III. VIABILITY STATEMENT  |   |
| The viability of the microorganism identified under II above was tested on 6 November 1998 <sup>2</sup> . On that date, the said microorganism was:<br><br><div style="display: flex; justify-content: space-between;"> <div style="width: 40%;"> <sup>3</sup><br/> <input checked="" type="checkbox"/> viable<br/> <sup>3</sup><br/> <input type="checkbox"/> no longer viable                 </div> <div style="width: 60%;"></div> </div> |   |

- 1 Indicate the date of the original deposit or, where a new deposit or a transfer has been made, the most recent relevant date (date of the new deposit or date of the transfer).
- 2 In the cases referred to in Rule 10.2(a)(ii) and (iii), refer to the most recent viability test.
- 3 Mark with a cross the applicable box.

Form BP/2 (first page)



|  |  |
|--|--|
| IV. CONDITIONS UNDER WHICH THE VIABILITY TEST HAS BEEN PERFORMED <sup>4</sup>          |  |
|  |  |
| V. INTERNATIONAL DEPOSITARY AUTHORITY  |  |
| Name: NCIM3 Ltd.,<br>Address: 23 St Machar Drive,<br>Aberdeen,<br>A24 1RY,<br>Scotland | Signature(s) of person(s) having the power<br>to represent the International Depositary<br>Authority or of authorised official(s):<br><br>Date: 29 November 1998 |

<sup>4</sup> Fill in if the information has been requested and if the results of the test were negative.

Form BP/9 (second and last page)

**EXHIBIT C2**  
**BUDAPEST TREATY ON THE INTERNATIONAL**  
**RECOGNITION OF THE DEPOSIT OF MICROORGANISMS**  
**FOR THE PURPOSES OF PATENT PROCEDURE**

Horticulture Research International  
 Wellesbourne  
 Warwickshire  
 CV35 9EF

**INTERNATIONAL FORM**

**VIABILITY STATEMENT**  
 Issued pursuant to Rule 10.2 by the  
**INTERNATIONAL DEPOSITARY AUTHORITY**  
 identified on the following page

NAME AND ADDRESS OF THE PARTY  
 TO WHOM THE VIABILITY STATEMENT  
 IS ISSUED

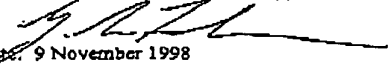
|  |   |
|--|---|
| <b>I. DEPOSITOR</b>  | <b>II. IDENTIFICATION OF THE MICROORGANISM</b>  |
| Name:<br>AS ABOVE<br>Address:  | Accession number given by the<br>INTERNATIONAL DEPOSITARY AUTHORITY:<br>NCIMB 40986<br><br>Date of the deposit or of the transfer <sup>1</sup> :<br>5 November 1998 |
| <b>III. VIABILITY STATEMENT</b>  |   |
| The viability of the microorganism identified under II above was tested on 6 November 1998 <sup>2</sup> . On that date, the said microorganism was:<br>3<br><input checked="" type="checkbox"/> viable<br>3<br><input type="checkbox"/> no longer viable |   |

<sup>1</sup> Indicates the date of the original deposit or, where a new deposit or a transfer has been made, the most recent relevant date (date of the new deposit or date of the transfer).

<sup>2</sup> In the cases referred to in Rule 10.2(n)(ii) and (iii), refer to the most recent viability test.

<sup>3</sup> Mark with a cross the applicable box.

Form BP/9 (first page)

|   |   |
|---|---|
| IV. CONDITIONS UNDER WHICH THE VIABILITY TEST HAS BEEN PERFORMED <sup>4</sup>           |   |
|   |   |
| V. INTERNATIONAL DEPOSITARY AUTHORITY   |   |
| Name: NCIME Ltd.,<br>Address: 23 St Machar Drive,<br>Aberdeen,<br>A24 3LX,<br>Scotland. | Signature(s) of person(s) having the power<br>to represent the International Depositary<br>Authority or of authorised official(s):<br><br>Date: 9 November 1998 |

<sup>4</sup> Fill in if the information has been requested and if the results of the test were negative.

Form BP/9 (second and last page)